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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,733	11/08/2002	Yoichi Kawashima	0388-020198	4588

7590 12/29/2005

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/049,733	<b>Applicant(s)</b> KAWASHIMA ET AL.	
	<b>Examiner</b> Jila M. Mohandesi	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's arguments, see remarks filed September 19, 2005, with respect to the rejection(s) of claim(s) 1-5, 10, 14-15 and 17-20 have been fully considered and are persuasive. Therefore, the rejection under 35 USC § 102/103 has been withdrawn and the finality of the previous Office action is hereby withdrawn. However, upon further consideration, a new ground(s) of rejections are made in view of copending application 10/493,877 and U.S. patent no. 5,261,572 (Strater). The after final amendment filed September 19, 2005 has been entered.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 3-5 and 17-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-23 of

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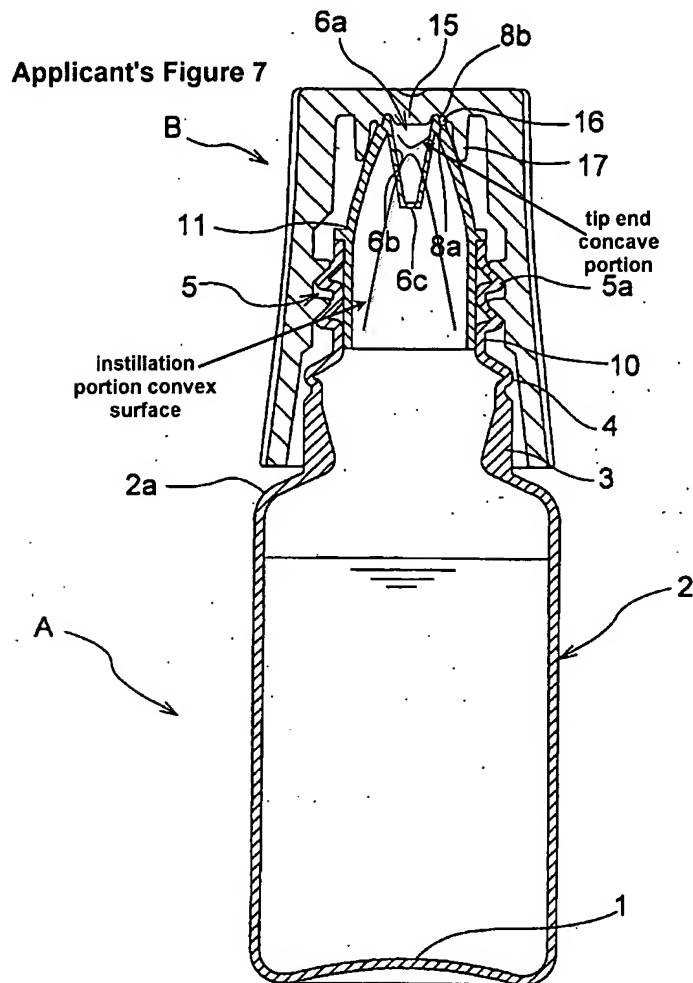
copending Application No. 10/493,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to an eye drop container with a dispensing body having a first hollow body segment having decreasing diameter as the distance from the tip end decreases; and a second body segment having increasing diameter as the distance from the tip end decreases.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. During the examination of this application it has been noted that the applicant has other applications that would be material to the examination of the instant application. Applicant is therefore respectfully reminded of the duty to disclose all information known to the applicant, which is material to the examination of the instant application in accordance with 37 CFR §1.56.

***Claim Language Interpretation***

5. The 'instilling portion comprising an extension of the body having an external generally conical convex surfaces that tapers to a tip end' as recited in claim 23 is interpreted to be the convex portion as supported by Applicant's figure 7.



***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

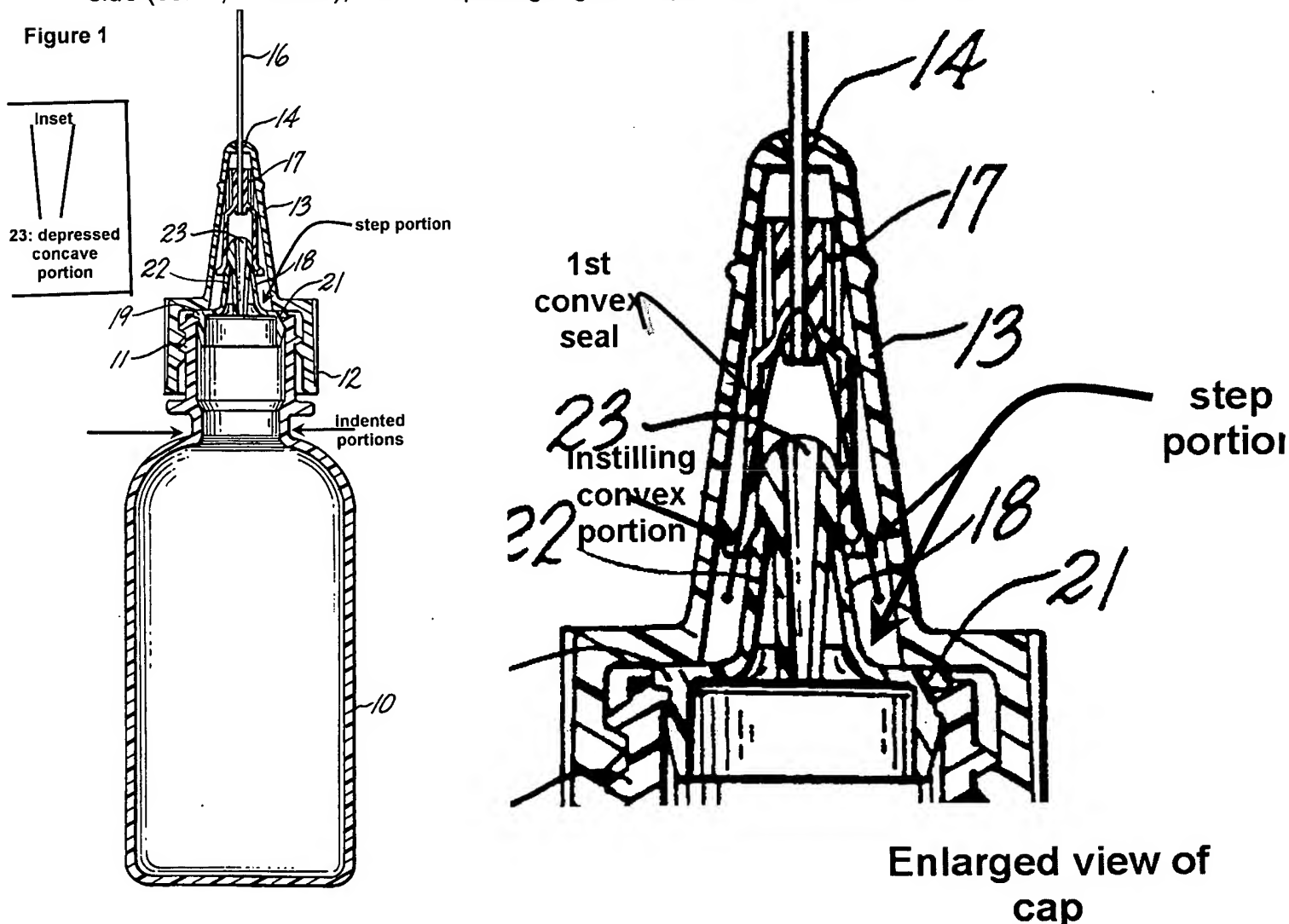
A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 3, 17-21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Strater (US 5,261,572; herein 'Strater'). Regarding claim 23 Strater discloses flexible plastic dispenser bottle/container 10 capable of dispensing any type of liquid drops (col. 1, ll. 60-62), and a screw cover/cap 12 that is screwed onto the bottle/container (col. 2, ll. 66-67, figure 1),

Wherein a conical concave depressed passage/fluid instilling portion 23 is provided at a tip of the container 10 whose internal diameter expands towards the tip side (col. 2, ll. 22-24), and comprising a generally convex surface that tapers to a tip



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end (enlarged figure 1) and an instilling hole 14 in the bottom end portion for dispensing liquid (col. 2, ll. 1-2);

Wherein cap 12 is provided with first convex seal portion which seals the concave portion of container 10 (enlarged view of cap of figure 1);

Wherein an outer circumferential region of instilling portion 23 is provided with a step portion with an outer diameter smaller *near* the tip end, and a tapered plug/tip protruding portion 1 located on the tip side of the step portion and with an outer diameter that is not substantially reduced or changed towards the tip (col. 2, ll. 10-13, figure 1); and

Wherein cap 12 is provided with circumferential flange/second convex seal portion 21 that is in close contact with the tip protruding portion and step portion (col. 2, ll. 14-17, figure 1).

Regarding claims 3 and 20 Strater discloses male thread/third convex guide portion 11 located at a radially outward spacing with respect to the second convex seal portion 21, the male thread/third convex guide portion 11 extending towards the container when mounted; and wherein the male thread/third convex guide portion 11 guides the cap when the cap is mounted (col. 1, ll. 65-66, figure 1).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-5 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater (US 5,261,572; herein 'Strater'). Strater *does not expressly disclose* a concave portion depth range, or tip opening diameter ranges. The concave portion depth range, or tip opening diameter ranges are result effective variables since these values affect the fluid drop size and are at least a result of the overall eyedropper container size. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Strater to contain these ranges, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesche and Slaney*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

The –product-by-process limitation in claims 22 and 23 result in no structure that is different from Hansen '474. The Product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps.

All the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed, "*Ex parte Masham* 2 USPQ2nd 1674. Also *Ex parte Casey* 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983).



Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See *In re Mott*, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. Note also that most of the distinctions argued are not present in the claims.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 3-5 and 17-24 have been considered but are moot in view of the new ground(s) of rejection.

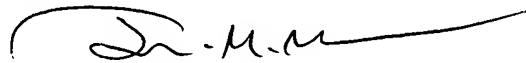
### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
December 21, 2005